REMARKS

I. Introduction

Applicant submits the present *Amendment with Request for Continued Examination* in conjunction with a *Request for Continued Examination* in response to the Final Office Action ("Final Action") mailed April 27, 2009. Applicant sincerely appreciates the thorough review of the present application that is reflected in the Final Action. In response to the Final Action, Applicant has amended Claims 2, 8, 11, 29, 31-32 and 36-37. In light of these claim amendments and the following remarks, Applicant respectfully submits that all of the claims are now in condition for allowance, which is respectfully requested.

II. The Rejections Under 35 U.S.C. § 102

Claims 2-5, 8-9, 27, 29 and 36 stand rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Publication No. EP 1096813 A2 to Koskinen et al. ("Koskinen"). (Final Action at 3). Applicant respectfully traverses these rejections.

A. The Rejection of Claim 2

Independent Claim 2 recites:

> 2. A method for a wireless terminal participating in a packet-switched communications session to provide notice of receipt of an incoming circuit-switched call, the method comprising:
>
> receiving a paging request associated with the incoming circuit-switched call; and
>
> notifying **a server that establishes and runs the packet-switched communications session** that the wireless terminal has received the incoming circuit switched call,
>
> wherein notifying the server that establishes and runs the packet-switched communications session that the wireless terminal has received the incoming circuit switched call comprises forwarding a notification message from the wireless terminal to the server **over a circuit-switched channel**.

The Final Action continues to take the position that Koskinen anticipates Claim 2. In particular, in response to Applicant's arguments that the cited portions of Koskinen do not disclose "forwarding a notification message from the wireless terminal to the server **over a circuit-switched channel**," the Final Action newly cites to Col. 8, lines 22-32 of Koskinen as

disclosing this recitation of Claim 2. Applicant respectfully submits, however, that the newly cited portion of Koskinen likewise fails to establish Koskinen as an anticipatory reference for at least two independent reasons.

First, the cited portion of Koskinen does not disclose or suggest forwarding a notification message to the "server that establishes and runs the packet-switched communications session" as is recited in Claim 2. While Koskinen discloses such a server "S" (*see, e.g.,* Koskinen at ¶¶ 0014, 0018 and FIG. 3), the newly cited portion of Koskinen does not discuss this server, but instead discusses the mobile terminal sending a paging response 110 to the base station subsystem BSS, the BSS transmitting a connection request 111 to the mobile switching center MSC, and the MSC transmitting information about the interruption to the serving GPRS support node SGSN. (*See* Final Action at 2, quoting Koskinen at Col. 8, lines 22-32). None of the BSS, the MSC or the SGSN comprise a "server that establishes and runs the packet-switched communications session" as is recited in Claim 2. As such, the newly-cited portion of Koskinen likewise fails to disclose forwarding a notification message from the wireless terminal to the server that establishes and runs the packet-switched communications session, and hence fails to anticipate Claim 2 for this reason.

Second, nothing in the newly cited portion of Koskinen discloses or suggests forwarding the above-discussed notification message "over a circuit-switched channel" as is further recited in Claim 2. In fact, the Response to Arguments section of the Final Action deos not even attempt to address Applicant's showing that Koskinen fails to disclose sending a notification message to the server over such a circuit-switched channel, and does not even attempt to explain what in the cited portion of Koskinen comprises (a) the server that establishes and runs the packet-switched communication or (b) the teaching that a notification message is sent to such a server over a circuit-switched channel. In fact, Koskinen appears to teach away from the method of Claim 2, as Koskinen teaches at blocks 107-109 of Fig. 1a and the description thereof that the wireless terminal sends a "No Operation" message to the server over what appears to be a **packet-switched connection** as opposed to over a circuit-switched connection. (Koskinen at Col. 7, line 56 through Col. 8, line 15 and Fig. 1a).

Thus, as the newly cited portion of Koskinen fails to disclose or suggest the above-discussed recitations of Claim 2, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 2 as anticipated by Koskinen.

B. The Rejections of Claims 3-5 and 8-9

Claims 3-5 and 8-9 each depend from Claim 1, and hence are patentable over Koskinen as depending from a patentable base claim. Additionally, Applicant respectfully submits that at least Claims 3-5 and 9 are independently patentable over Koskinen.

In particular, Claim 3 recites, among other things, that the "circuit-switched channel is the SMS data bearer." The Final Action cites to Col. 1, lines 307-42 and Col. 6, lines 22-29 of Koskinen as disclosing the recitations of Claim 3. (Final Action at 3 and 4). However, the passage at Col. 1, lines 30-42 of Koskinen simply states that GPRS service supports Short Message Service transmissions. This passage from Koskinen does **not** teach forwarding a notification message from the wireless terminal to the server over the SMS data bearer channel as is expressly recited in Claim 3. Likewise, Col. 6, lines 22-29 of Koskinen merely states that the mobile terminal disclosed therein has both circuit switched and packet-switched communications means. In fact, the Final Action essentially concedes that Koskinen does not teach the recitations of Claim 3 by arguing that the SMS bearer is an "alternative communication mechanisms" that is "available" as opposed to pointing to any teaching that a notification message is actually sent over the SMS bearer. Moreover, FIG. 1A and the discussion thereof clearly show that the only notification message sent from the wireless terminal is the "No Operation" command 107/108/109, which Koskinen appears to indicate is carried over a packet-switched connection. (*See* Koskinen at Col. 8, lines 1-15). Thus, as neither of the cited portions of Koskinen disclose the recitations of Claim 3, Claim 3 is independently patentable over Koskinen, as are Claims 4 and 5 which depend therefrom.

Claim 4 recites that "the notification message comprises a text message or an e-mail message transmitted over the SMS data bearer." The Final Action cites to Col. 1, lines 37-42 of Koskinen as disclosing the recitations of Claim 4. (Final Action at 4). However, this passage of Koskinen simply states that GPRS service supports Short Message Service transmissions, and does not teach that the notification message forwarded over the SMS data

bearer channel comprises a text message or an e-mail message as is expressly recited in Claim 4. Thus, Claim 4 is independently patentable over Koskinen for this additional reason.

Claim 5 recites that "the notification message is forwarded via an IP level connection over the SMS data bearer." Once again, the Final Action cites to Col. 1, lines 37-42 of Koskinen as disclosing the recitations of Claim 5. (Final Action at 4). However, the cited passage from Koskinen says nothing about forwarding a notification message to a server associated with a packet-switched communications session that the wireless terminal has received the incoming circuit switched call "via an IP level connection over the SMS data bearer" as is expressly recited in Claim 5. Thus, Claim 5 is independently patentable over Koskinen for this additional reason.

Claim 9, in conjunction with its dependency from Claim 8, recites "notifying the server that establishes and runs the packet-switched communications session upon termination of the incoming circuit-switched call," where the notification "is forwarded over a circuit-switched channel." The Final Action cites to Col. 6, lines 25-29 and Col. 9, lines 41-47 of Koskinen as disclosing the recitations of Claim 9. (Final Action at 5). However, the cited portions of Koskinen do not disclose or suggest forwarding a notification to the server that establishes and runs the packet-switched communication over a circuit-switched channel as is recited in Claim 9. In fact, as is expressly stated in Koskinen and shown in FIG. 1B, after the circuit switch call is terminated the only messaging that occurs is a message from the MSC to the SGSN that is used to reactivate the packet-switched connection. Thus, no message is sent to the server "S" that establishes and runs the packet-switched communications session, let alone is any such message sent over a circuit-switched channel. Thus, Claim 9 is independently patentable over Koskinen for at least this reason.

C. The Rejection of Claim 27

Independent Claim 27 recites:

> 27. A wireless terminal, comprising:
>
> a transceiver; and
>
> a packet-switched suspension notification circuit coupled to the transceiver that is configured to generate a notification message that is suitable for transmission as an e-mail message or a test message over a circuit switched SMS data bearer to a

server controlling a packet-switched communications session when the wireless terminal temporarily suspends participation in the packet-switched communications session, and

a circuit-switched communications circuit, wherein the packet-switched suspension notification circuit generates the notification message in response to receipt of a circuit-switched page by the circuit-switched communications circuit.

The Final Action states that Fig. 2a, and Col. 7, line 56 through Col. 8, line 13 of Koskinen discloses all of the recitations of Claim 27. Claim 27 recites that the packet-switched suspension notification circuit "is configured to generate a notification message that is suitable for transmission as an e-mail message or a test message over a circuit switched SMS data bearer to a server controlling a packet-switched communications session." As discussed above with respect to the rejections of Claims 2-4, Koskinen does not disclose any such packet-switched suspension notification circuit. Accordingly, the rejection of Claim 27 should be withdrawn for this reason.

D. The Rejection of Claim 29

Claim 29 recites:

29. A computer program product implemented in a wireless terminal that is participating in a packet-switched communications session that provides notice of receipt of an incoming circuit-switched call, comprising:

a computer readable medium having computer readable program code embodied therein, the computer readable program code comprising:

computer readable program code configured to receive a paging request associated with the incoming circuit-switched call;

computer readable program code configured to notify a server that establishes and runs the packet-switched communications session via a text message or an e-mail message that is transmitted over a circuit-switched SMS data bearer channel that the wireless terminal has received the incoming circuit switched call; and

computer readable program code configured to notify the server that establishes and runs the packet-switched communications session over the circuit-switched SMS data bearer channel upon termination of the incoming circuit-switched call.

Applicant respectfully submits that Koskinen does not disclose either of the last two recitations of Claim 29, as is discussed above with respect to various of the other claims. Accordingly, the rejection of Claim 29 as anticipated should be withdrawn.

E. The Rejection of Claim 36

Claim 36 recites:

> 36 A method for a wireless terminal participating in a packet-switched communications session to provide notice of receipt of an incoming circuit-switched call, the method comprising:
>
> receiving a paging request associated with the incoming circuit-switched call;
>
> notifying a server that establishes and runs the packet-switched communications session **over a circuit switched SMS data bearer** channel that the wireless terminal has received the incoming circuit switched call; and
>
> forwarding a notification message from the wireless terminal to the server that establishes and runs packet-switched communications session via a text message or an e-mail message that is transmitted over the circuit-switched SMS data bearer channel upon termination of the incoming circuit-switched call;
>
> wherein the incoming circuit-switched call comprises a circuit-switched call transmitted over a GSM network.

The Final Action states that Koskinen anticipates Claim 36. Applicant respectfully submits, however, that Koskinen fails to disclose or suggest at least two of the recitations of Claim 36.

First, Claim 36 recites "notifying a server . . . over a circuit switched SMS data bearer channel that the wireless terminal has received the incoming circuit switched call." The Final Action cites to Col. 1, lines 37-42 and Col. 7, line 58 through Col. 8, line 13 of Koskinen as disclosing this recitation of Claim 36. However, as discussed in detail above in Applicant's response to the rejection of Claims 2 and 3, Koskinen does not disclose sending a notification to the server associated with the packet-switched communications session **over a circuit switched SMS data bearer channel**. Instead, the "No Operation" message that is sent in Koskinen appears to be sent over the existing packet-switched connection. Thus, Koskinen fails to anticipate Claim 36 for this reason.

Second, Claim 36 further recites "notifying a server that establishes and runs the packet-switched communications session . . . that the wireless terminal has received the incoming circuit switched call." In particular, as discussed above with respect to the rejection of Claim 2, while Koskinen discloses a server "S" that runs the packet-switched communication session, no notification is forwarded to this terminal. As such, the newly-cited portion of Koskinen likewise fails to disclose forwarding a notification message from

the wireless terminal to the server that establishes and runs the packet-switched communications session, and hence fails to anticipate Claim 36 for this additional reason.

Accordingly, the rejection of Claim 36 should likewise be withdrawn.

III. The Rejections Under 35 U.S.C. 103

Claims 6 and 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen in view of U.S. Patent Publication No. 2005/0041640 to Nasielski et al. ("Nasielski"). (Final Action at 7). Claims 11, 31-32, 34 and 37-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Koskinen in view of U.S. Patent Publication No. 2004/0142694 to Levy et al. ("Levy"). (Final Action at 8). Applicant also respectfully traverses these rejections.

A. The Rejection of Claim 11

Claim 11, as amended, recites:

> 11. A method for a wireless terminal participating in a packet-switched push-to-talk communications session to provide notice of receipt of an incoming circuit-switched call, the method comprising:
>
> receiving a paging request associated with the incoming circuit-switched call;
>
> notifying a push-to-talk server that is running the packet-switched push-to-talk communications session that the wireless terminal has received the incoming circuit switched call;
>
> notifying a remote terminal that was part of the push-to-talk session that the wireless terminal has temporarily suspended participation in the packet-switched push-to-talk communications session; and then
>
> the wireless terminal notifying the push-to-talk server that is running the packet-switched push-to-talk communications session that the temporary suspension of the push-to-talk session is over.

The Final Action cites to Fig. 1a, Col. 7, line 28 through Col. 8, line 13 of Koskinen as disclosing all of the recitations of Claim 11 except for (1) notifying a remote terminal of suspension of the packet-switched communication session and (2) that the packet-switched communication session comprises a push-to-talk session, which the Final Action states is taught by Levy. (Final Action at 8). Applicant respectfully traverses the rejection of Claim 11.

In particular, Claim 11 has been amended to further recite "the wireless terminal notifying the push-to-talk server that is running the packet-switched push-to-talk communications session that the temporary suspension of the push-to-talk session is over." Koskinen does not disclose this newly added recitation of Claim 11, as the only notification performed in Koskinen relating to reactivation of the packet-switched connection is the "packet connection activated message that is sent from the MSC/VLR to the SGSN. (*See* Koskinen at Fig. 1a). Levy likewise fails to disclose or suggest the newly added recitation of Claim 11, as in Levy the control system 108 automatically searches for a better channel and reestablishes the connection once such a channel is identified. (*See, e.g.,* Levy at ¶¶ 0015-0016). As such, the rejection of Claim 11 should be withdrawn for these reasons.

B. The Rejections of Claims 6, 31-32, 34 and 37-39

Claims 6, 31-32, 34 and 37-39 each depend either directly or indirectly from Claim 2 or Claim 36, and hence are patentable over the cited art at least as depending from a patentable base claim. In addition, Applicant respectfully submits that at least Claims 6 and 34 are independently patentable over the art cited in the Final Action.

In particular, Claim 6 recites that "the notification message includes an identification associated with the wireless terminal and/or an estimate of the length of the incoming circuit-switched call." The Final Action cites to Nasielski at ¶ 0032, lines 6-9 as disclosing the recitations of Claim 6. The cited portion of Nasielski teaches that the Internet Protocol address of a wireless terminal **102** may be appended to a notification message forwarded by a voice message server **110** (e.g., a voicemail server) "so that the PDSN **114** can route the notification to the intended subscriber station **102** using the existing packet data session." (Nasielski at ¶ 0032). However, as is clear from a review of Nasielski, the notification message discussed therein is a notification message that is forwarded from a packet data serving node **114** to the voice message server **110**. As such, this notification is clearly not from "the wireless terminal" as is the notification message of Claim 6 and, in fact, the only reason that the IP address of the wireless terminal is appended to the notification is so that the packet data serving node **114** will know where to route the notification. As such, Nasielski clearly does not teach the recitation of Claim 6, nor does the cited combination of Nasielski and Koskinen result in the method of Claim 6.

Claim 34 recites that the circuit-switched channel is the SMS data bearer. The Final Action cites to Koskinen as disclosing the recitations added by Claim 34. However, as is discussed in detail above in Applicant's response to the rejection of Claim 3, Koskinen does not disclose or suggest using the SMS data bearer to notify a server associated with a packet-switched communications session that the wireless terminal has received an incoming circuit-switched call. Accordingly, Claim 34 is independently patentable over the cited art.

Claim 37 recites that "the packet-switched communications session comprises a push-to-talk session, wherein the server that establishes and runs the packet-switched communications session maintains a Packet Data Protocol context associated with the push-to-talk session throughout the duration of the circuit switched call, and wherein the method further comprises resuming the push-to-talk session under the existing Packet Data Protocol context after termination of the circuit-switched call." The Final Action cites Koskinen at Col. 8, lines 3-7 as resuming the session after termination of the circuit-switched call, and cites to Levy as disclosing the remaining recitations of Claim 37. (Final Action at 10-11). Applicant respectfully submits, however, that the cited portions of Levy do not discuss "the server that establishes and runs the packet-switched communications session maintains a Packet Data Protocol context associated with the push-to-talk session throughout the duration of the circuit switched call" as is recited in Claim 37. In fact, the cited portion of Levy instead states that "the system control automatically establishes a new dispatch call link" as opposed to resuming the session under an existing Packet Data Protocol. Accordingly, Claim 37 is also independently patentable over the cited art.

Claim 38 recites "notifying a remote wireless terminal that is part of the push-to-talk session that the wireless terminal has temporarily suspended participation in the push-to-talk session." As discussed above with respect to the rejection of Claim 11, the combination of Koskinen and Levy does not fairly teach or suggest providing such notification. Thus, Claim 38 is independently patentable over the cited art.

Claim 39 recites that "the notification message includes an identification associated with the wireless terminal and/or an estimate of the length of the incoming circuit-switched call." As discussed above with respect to the rejection of Claim 11, the combination of

Koskinen and Nasielski does not fairly teach or suggest providing such an identification. Thus, Claim 39 is also independently patentable over the cited art.

IV. Conclusion

For the above reasons, Applicant respectfully submits that the present application is in condition for allowance, which is respectfully requested.

Respectfully submitted,

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